REMARKS

Applicant respectfully request reexamination and reconsideration of the application in view of the amendments and following remarks.

Claims 4 and 12-14 have been canceled and claim15 has been amended to depend from claim 1.

The Examiner has objected to the drawings stating that claim 4 claims a feature not shown in the drawings.

Applicant has canceled the claim in order to expedite prosecution of the application.

The Examiner has rejected claims 1-3, 9 and 11 under 35 USC §102(b) as being anticipated by Livingstone (RE 25906).

Applicant traverses the rejection and respectfully requests that the Examiner withdraw the rejection in view of Applicant's amendment to the claims and the following remarks.

It is well settled law that a claim is anticipated only if each and every elements as set forth in the claim is found, either expressly or inherently described, in a single prior art reference in as complete detail as is contained in the claim. Moreover, it is not sufficient that the prior art reference disclose all of the elements in isolation. Rather, "[a]nticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim." Lindemann Mashchinefabrik GmbH v. American Hoist & Derrick Co., 730 F.2d 1452, 221 U.S.P.Q. 481,485 (Fed. Cir. 1984) emphasis added).

Applicant traverses the rejection and respectfully requests that the Examiner withdraw the rejection in view of Applicant's amendment to the claims and the following remarks..

At column 8, lines 21-29, th Livingstone references states:

"If the cover has a different coefficient of expansion from the container and a change in temperature causes a change in the dimensions of the cover, contraction of the cover causes the outer wall of the groove in the cover to pull against the rim and expansion of the cover causes fee inner wall of the groove and the portion of the cover between it and the portion of largest diameter to press outwardly, forming a seal between the cover and the inner wall of the rim. "

Applicant claims that heating of the members forms a vent in the seal between the first member and the second member wherein the cited Livingstone reference states that the difference in the coefficient of expansion aids in forming a seal between the cover and inner wall of the rim which language is contradictory to the claim language of Applicant's independent claim 1 and therefor not anticipated. Moreover, the claims 2-3, 9, and 11 depend upon claim 1 and are not anticipated for the same reasons.

The Examiner has rejected claims 4-8 under 35 USC §103(a) as being unpatentable over Livingstone in view of Fritz.

Claim 4 has been canceled.

Applicants respectfully traverses the rejection for none of the references show all of the features of Applicant's claimed invention. Accordingly, Applicants' respectfully submit that none of the references alone or in combination, discloses or suggests applicants' invention described in 5-8.

In this regard, the Court of Appeals for the Federal Circuit has repeatedly held that, for a combination of references to be proper, the references themselves, or some other prior art knowledge, must suggest the desirability of the combination or provide some motivation or incentive to put the combination together. As stated in In re Gordon, 733 F.2d 900, 902, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984):

> The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification (emphasis added).

See also, e.g., Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1143, 227 U.S.P.Q. 543, 551 (Fed. Cir. 1985); In re Grabiak, 769 F.2d 729, 731 226 U.S.P.Q. 870, 872 (Fed. Cir. 1985); In re Sernaker, 702 F.2d 989, 994, 217 U.S.P.Q. 1, 5 (Fed. Cir. 1983); W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1550, 220 U.S.P.Q. 303, 311 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

It is thus improper to first determine what is claimed as the invention at issue and then select isolated facts from the prior art to reconstruct the claimed invention.

> We are required to evaluate the claimed subject matter as a whole against the teachings of the prior art references of record. 35 U.S.C. §103. References are evaluated by ascertaining the facts fairly disclosed therein as a whole. It is impermissible to first ascertain factually what appellants did and then view the prior art in such a manner as to select from the random facts of that art only those which may be modified and then utilized to reconstruct appellants' invention from such prior art. Application of Shuman, 361 F.2d 1008, 1012 (C.C.P.A. 1966).

Such an analysis is improper and cannot establish obviousness because it necessarily requires the use of hindsight gained from the inventor's own disclosure.

> Hindsight ... is quite improper when resolving the question of obviousness. To use the patent in suit as a guide through the morass of prior art references, combining the right references in the right way to arrive at the result of the claims in suit ... is also quite improper. Medtronic, Inc. v. Daig Corp., 611 F.Supp. 1498, 1534, 227 U.S.P.Q. 509, 535 (D. Minn. 1985), aff'd, 789 F.2d 903 (Fed. Cir.), cert. denied, 479 U.S. 931 (1986).

Applicants submit that, as in the foregoing authorities, a combination of Livingtstone and Fritz or Husband or Hakim herein would be improper because the references themselves are completely silent with respect to such a combination.

Moreover, a combination of the Livingtstone and Fritz or Husband or Hakim references would improperly disregard the "**teaching away**" disclosure. It has expressly held that in

determining whether a combination of prior art references is proper, consideration must be given to those portions of a reference which teach away from the claimed invention.

> In its consideration of the prior art, however, the district court erred ... in considering the references in less than their entireties, i.e., in disregarding disclosures in the references that diverge from and teach away from the invention at hand. W.L. Gore & Assoc., Inc. v. Garlock, Inc., 721 F.2d 1540, 1550, 220 U.S.P.Q. 303, 311 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).
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> As the ALJ recognized, prior art references before the tribunal must be read as a whole and consideration must be given where the references diverge and teach away from the claimed invention. Akzo N.V. v. U.S. Intern. Trade Com., 808 F.2d 1471, 1481, 1 U.S.P.Q.2d 1241, 1246 (Fed. Cir. 1986), cert. denied, 482 U.S. 909 (1987) (emphasis added).

Clearly the Livinston reference teaches at column 8, lines 20-29 that the difference in the coefficient of friction forms a tighter seal between the container and lid which is contrary to Applicant's claimed invention that the coefficient of friction between the lid and container forms the vent.

The Examiner has rejected claim10 under 35 USC §103(a) as being unpatentable over Livingstone in view of Husband..

Applicants respectfully traverses the rejection for none of the references show all of the features of Applicant's independent claim1 from which claim 10 depends an for the reasons set forth above.

The Examiner has rejected claim12-15 under 35 USC §103(a) as being unpatentable over Livingstone in view of Husband..

Applicants respectfully requests that the rejection be withdrawn in view of the cancellation of claims 12-14. Applicant traverses the rejection of claim 15 for none of the references show all of the features of Applicant's independent claim1 from which claim 15 depends.

For all of the foregoing reasons, Applicant submits that the claims are patentable over the cited references and that the application is in condition for allowance. Accordingly, Applicant respectfully requests prompt reconsideration and receipt of the formal Notice of Allowance. If the Examiner believes there are other unresolved issues in this case, Applicant's attorney would appreciate a telephone call at (502) 452-1233 to discuss any such remaining issues.

Respectfully submitted,

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